

REMARKS

Claims 1-23 are pending in the application.

Claims 1-23 are subject to a restriction.

Restriction and Election of Species

A previous restriction has been issued on July 15, 2005 with a response sent on October 12, 2005.

The previous restriction requirement is withdrawn and replaced by a new one.

The Applicants elect Group I, drawn to a paint and encompassing claims 1-6, 10-17 and 23.

The Applicants are further requested to elect a single disclosed resin, a single disclosed coloring agent and a single disclosed binder resin.

The Applicants are unclear as to why a species election of a binder resin is required as a binder resin element is not part of any claim. Nevertheless, Applicants have made an election as required.

The Applicants elect **a urea-aldehyde resin** found in examples 1-3 on page 8 of the disclosure; a coloring agent of **C.I. Pigment Red 254** shown in example 1 and a binder **comprising copolymer of acrylic and methacrylic acid esters**. See page 2, paragraph 3.

When all of the single species components are elected, claims 1, 2, 3, 5, 10, 11, 12 and 16 encompass the combined elements.

The Applicants traverse the restriction requirement for basically the same reasons given on October 12, 2005.

All the elements of claim 1 are present in claims 7 and 8. All the elements in claim 22 are present in claims 9, 20 and 21. All the elements present in claim 10 are present in claims 18 and 19. Thus, if claims 1-6, 10-17 and 22 and 23 be allowed, the claims of Groups II and III should also be allowed.

The Examiner has failed to establish that it would be a serious burden to examine the entire application. See MPEP § 803. Indeed, from the search required for Group I, it appears to that very little additional burden would be required. It is respectfully noted that a mere difference in

classification is not an appropriate basis for restriction. The classification system was set up for purposes of information retrieval (35 U.S.C. § 9), and not for the purpose of establishing the propriety of a restriction requirement (35 U.S.C. § 121).

Therefore Applicants will request rejoining of claims 7-9 and 18-21 upon allowance of claims 1-6 and 10-17. This should be advantageous to the Office as well as the present Applicants as the rejoining will save resources for both parties.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Shiela A. Loggins
Agent for Applicants
Reg. No. 56,221

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-2768
SAL\22844res.doc